

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES***

Applicant: Lautenbacher, Markus

Title: SERVICE SYSTEM FOR
AN IP-BASED
COMMUNICATION
NETWORK

Appl. No.: 09/868,277

International
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§ 371(c) Date: 06/15/2001

Examiner: Nawaz, Asad M.

Art Unit: 2155

Confirmation No.: 7143

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDED (THIRD) BRIEF ON APPEAL

In response to the Notification of Non-Compliant Appeal Brief (37 C.F.R. § 41.37), dated December 31, 2007, the Appellant submits this Amended Brief on Appeal which includes a statement of the status of all claims and identifies the appealed claims. Citations are to the paragraphs in the Second Substitute Specification. This Amended Brief on Appeal is submitted within one month of the Notification of Non-Compliant Appeal Brief and is timely filed.

REAL PARTY IN INTEREST

The application has been assigned of record to Siemens Aktiengesellschaft, having a place of business at Wittelsbacherplatz 2, 80333 Muenchen, Germany. The Assignment was recorded in the records of the United States Patent and Trademark Office at Reel/Frame 012022/0268 on June 15, 2001.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

This is an appeal from the Office Action mailed October 2, 2006. Paragraph 1, page 2 of the Office Action acknowledged that claims 16-20, 24-26 and 30-31 are pending. Claims 1-15 and 21-23 were previously cancelled. Claims 27-29 are withdrawn.

The October 2, 2006 Office Action finally rejected claims 16-20, 24-26, 30 and 31.

Claims 16-20, 24-26, 30 and 31 are on appeal.

STATUS OF AMENDMENTS

The Appellant has filed no amendment subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 16

Claims 16 is directed to a system in an IP-based network (paragraph 0001, Fig. 1). The system includes at least one server storing application programs for implementing user specific subscribable services on a per user basis (paragraphs 0015, 0041, 0042, 0046). *The server stores the application programs until a user requests a specific application program. (See Fig. 2)*

A terminal is coupled to the server and has on-demand access to the IP-based network for requesting downloadable programs corresponding to said services (paragraphs 0015, 0053, Fig. 4). The application programs can be executed at the terminal (paragraph 0013). The downloadable programs are configured to interwork with the application programs on at least one other terminal of the network for realizing user services (paragraph 0059). *The user downloads the specific application to the user's terminal where the application program is executed. (See Fig. 4) The network only functions as a pure transport offering no specific network services. (See paragraphs 0022, 0023 and 0065)*

Claims 17-20 and 30 depend from independent claim 16.

Independent Claim 24

Claims 24 is directed to a terminal in an IP-based network (paragraph 0001). The terminal includes a client component for on demand requesting of user downloadable application software from a server (paragraphs 00015 and 0053). The application software is configured to interwork with the application software on at least one other terminal for the network for realizing user services, and is capable of implementing user subscribable services (paragraph 0044). *The server stores the application programs until a user requests a specific application program. (See Fig. 2) The user downloads the specific application to the user's terminal where the application program is executed. (See Fig. 4) The network only functions as a pure transport offering no specific network services. (See paragraphs 0022, 0023 and 0065)*

Claims 25, 26 and 31 depend from independent claim 24.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 16-20, 24-26 and 30-31 comply with 35 U.S.C. § 112, first paragraph.

Whether claims 16-20 and 24-26 are anticipated under 35 U.S.C. § 102(e) by Devarakonda et al (USPN: 6,757,729).

Whether claims 30-31 are obvious under 35 U.S.C. § 103(a) in view of Devarakonda et al, further in view of Brocker et al (USPN: 5,365,606).

ARGUMENT

I. LEGAL STANDARDS

Compliance under 35 U.S.C. § 112

The claims have been rejected under 35 U.S.C. § 112, first paragraph, which states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

II. REJECTION OF CLAIMS 16-20, 24-26 AND 30-31

In the office action mailed October 2, 2006, on page 2, paragraph 3, the Examiner rejected claims 16-20, 24-26, and 30-31 under 35 U.S.C. § 112, first paragraph.

In commenting on the rejection of the cited claims, the Examiner states “the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time of the application was filed, had possession of the claimed invention. More specifically, the added limitation of the interworking programs with applications on at least one other terminal is not found in the specification.”

The Applicant submits that the specification, as originally filed, does contain support for the language added to independent claims 16 and 24 in the June 23, 2006 amendment. Support for the added limitation can be found in paragraphs 0018-0013 and paragraph 0059 in the second substitute specification filed February 9, 2005.¹

¹ The second substitute specification added paragraph numbers in accord with PTO practice at the time. However, the language in the above cited paragraph numbers are substantially the same as in the originally filed application found at page 5 at least in lines 29-33.

Accordingly, the Applicant submits that the specification, as originally filed, at least in the paragraphs cited above, provide the support and description of the claims currently pending in this application. Therefore, the Applicant respectfully requests that the rejection of claims 16-20, 24-26 and 30-31 be withdrawn.

III. LEGAL STANDARDS

ANTICIPATION UNDER 35 U.S.C. § 102(e).

The claims have been rejected under 35 U.S.C. § 102(e), which states:

A person shall be entitled to a patent unless . . .

(e) the invention was described in (1) an application for patent, published under section 122(b) by another filed in the United States before the invention by the application for patent or (2) a patent granted on an application for another filed in the United States before the invention by application for patent, . . .

The legal standards for anticipation under 35 U.S.C. § 102 are well-settled. The “basic test” for anticipation of a patent claim by a prior art reference is this: to establish anticipation, there must be “identity of invention: the claimed invention, as described in appropriately construed claims, must be the same as that of the reference.” Glaverbel S.A. v. Northlake Mktg. & Supply, Inc., 45 F.3d 1550, 1554, 33 U.S.P.Q.2d 1496, 1498 (Fed. Cir. 1995); see also Cont’l Can Co. v. Monsanto Co., 948 F.2d 1264, 1267, 20 U.S.P.Q.2d 1746, 1748 (Fed. Cir. 1991). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

IV. REJECTION OF CLAIMS 16-20 AND 24-26

In the office action mailed October 2, 2006, claims 16-20 and 24-26 as being anticipated by Devarakonda et al (USPN: 6,757,729).

In commenting on the rejection of each of the independent claims, 16 and 24, the Examiner states that “Devarakonda teaches in an IP-based network a system comprising: at least one server storing application programs for implementing user specific subscribable services, said server storing said services on a per user basis; abstract; (Fig. 1, col. 2, 28-40; col. 3, 50-56; col. 4, 1-5 and 38-40).

Further on page 3, the Examiner states “in at least one terminal coupled to the server and having an on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to network with the application program on at least one other terminal of the network for realizing user services (Fig. 1; col. 4, 43-44; col. 6, 4-8).”

V. REJECTION OF CLAIMS 16-20 AND 24-26 IS IMPROPER BECAUSE THE CITED REFERENCE FAILS TO DISCLOSE AT LEAST ONE ELEMENT OF EACH OF THE REJECTED INDEPENDENT CLAIMS.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. Verdegaa
Bros. vs. Union Oil Company, 814 F.2d 628, 631, 2 USPQ 2d, 1051, 1053 (Fed. Cir. 1987). As explained below the Examiner’s rejection of claims 16-20 and 24-26 is improper because Devarakonda et al fails to disclose at least one element of each of the rejected claims.

Devarakonda provides network-based services, in other words, services provided by the network applications on network computers in a flexible and portable way. (See col. 1, lines 41-43) Devarakonda utilized a virtual environment manager (VEM) which makes it possible for applications on said network computers to use **services provided and executed by the network** in a way that is independent of the architecture of the network computer and the server with which the network computer connects itself for execution of the application. (See col. 1, lines 45-54) Accordingly, the virtual environment of Devarakonda is used to make possible for applications in a computer platform to independently use **services provided and executed by the network**.

In response to the arguments in the office action, as cited above, at page 6 of the office action, the Examiner believes that “the VEM environment is essentially the same as the AXE (Application Execution Component) of the instant application. The aim of both environments is to allow platform independent execution”.

The Applicant submits that the present application discloses a system that is opposite as that taught Devarakonda and that the VEM is not equivalent of the AXE of the present application and therefore Devarakonda does not include at least one element of each of the rejected independent claims. Claims 16 and 24 are in independent form. Independent claims 16 and 24 (as amended) recite together with other elements “said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services.”

The system in an IP based network in which downloadable programs are configured to interwork with application programs on at least one other terminal of the network for realizing user services as required by independent claims 16 and 24 (as amended) is not disclosed, taught or suggested by Devarakonda.

Further, the Applicant respectfully traverses the Examiner's characterization of application execution component (AXE) as disclosed in the present application. In the present application, the server stores specific subscribable services which are accessible, on demand, by a user at a terminal connected to the server through the network in which the downloadable program corresponding to the services can be executed. The application execution component (AXE) is downloaded once to the intelligent terminal. User's services that are accessible from the network are downloaded to the User's terminal and executed in the application execution component residing on the terminal. Several examples of such arrangement are described at least in paragraphs 0057-0074 of the second substitute specification. As particularly noted in paragraph 0065 of the second substitute specification, as originally, filed, "the important point to note here is that User services, in this particular case supplementary services for internet telephoning are associated with applications running on the intelligent terminal, not in some sort of central network entity". In other words, the present application describes and claims a system in which the execution of the services are delegated to the terminals and not executed in the network. Devarakonda teaches that the **services are provided in the network.**

Accordingly, does not anticipate that which is disclosed and claimed in the present application under 35 U.S.C. § 102(e).

Therefore, the Applicant submits that independent claims 16 and 24, as amended, are not anticipated by Devarakonda. Further, since independent claims 17-20 and 30, which depend from independent claim 16; and claims 25-29 and 31, which depend from independent claim 24 are also not anticipated by Devarakonda. Therefore, the Applicant respectfully requests that the rejection of claims 16-20 and 24-26 under 35 U.S.C. § 102(e) be withdrawn.

VI. LEGAL STANDARDS

The claims have been rejected under 35 U.S.C. § 103(a), which states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 103(a).

Obviousness under 35 U.S.C. § 103(a) is a legal conclusion involving four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of non-obviousness. See Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office (PTO), the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). A prima facie case of obviousness requires that the prior art reference or references teaches or suggests all of the claimed limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

VII. REJECTION OF CLAIMS 30 AND 31

In the office action mailed October 2, 2006, the Examiner rejected claims 30 and 31 under 35 U.S.C. § 103(a) as being anticipated by Devarakonda et al (USPN: 6,757,729) further in view of Brocker et al (USPN: 5,365,606).

In commenting on the rejection of dependent claims 30 and 31, the Examiner states that “As to claim 30, Devarakonda teaches the system in claim 16, however, Devarakonda does not explicitly indicate that the Application execution environment as being ported to the terminal only once. Brocker et al teaches a virtual software machine that runs multiple program modules in a single address space of the target computer. Thus, the application execution environment is ported only once to the terminal. (Col. 1, line 62- Col. 2, line 13) It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Brocker in combination of those Devarakonda to make the system more efficient. Such a system would reduce operating system resource consumption and increase transaction time (col. 1, lines 56-57). As to claim 31, the Examiner states that “Claim 31 presents no new limitations above claim 30 and is thus rejected under similar rationale.”

A response to the arguments in the office action, as cited above, at page 6 of the office action, the Examiner states “the rejection under 103(a) applied to the independent claims has been withdrawn. However, it should be noted that when combining references to formulate a rejection, the overlapping teachings of each reference should not be construed as repetitive or redundant. Rather, it should show that the two references are easily combinable since they have common operations and components.”

VIII. REJECTION OF CLAIMS 30 AND 31 IS IMPROPER BECAUSE THE CITED COMBINATION OF REFERENCES DOES NOT TEACH OR SUGGEST SUCH COMBINATION.

To establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (C.C.P.A. 1974).

The Applicant submits that the suggested combination of Devarakonda and Brocker would create a redundancy in application execution since the virtual environment manager (VEM) of the Devarakonda seems to be similar to the task manager control module of Brocker (see col. 2, lines 18-13 of Brocker). Therefore, substituting the virtual environmental manager of Devarakonda with the task manager control module of Brocker does not change the execution of the software from the network to the terminal as disclosed and claimed in the present application.

Further, claim 30 depends from independent claim 16 and claim 31 depends from independent claim 24. The Examiner has acknowledged that the rejection under 103(a) applied to the independent claims has been withdrawn. Since the combination of Devarakonda and Brocker is not applicable to the independent claims 16 and 24, the rejection of the dependent claims 30 and 31 would also not be obvious. Dependent claims 30 and 31 which depend from independent claims 16 and 24 respectively, are also patentable. See 35 U.S.C. § 112, paragraph four. Accordingly, the Applicant respectfully requests that the Examiner withdraw his rejection of claims 30 and 31 under 35 U.S.C. § 103(a).

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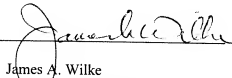
IX. CONCLUSION

In view of the foregoing, the Appellant submits that claims 16-20, 24-26 and 30-31 are in compliance with 35 U.S.C. § 112, first paragraph; claims 16-20 and 24-26 are not properly rejected as being anticipated under 35 U.S.C. § 102(e); and claims 30 and 31 are not properly rejected as being anticipated by Devarakonda et al (USPN: 6,757,729) further in view of Brockner et al (USPN: 5,365,606). Accordingly, the Appellant respectfully requests that the Board reverse the claim rejections and order that a Notice of Allowance respecting all pending claims be issued.

Respectfully submitted,

Date 01-30-08

By



FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5776
Facsimile: (414) 297-4900

James A. Wilke
Attorney for the Applicant
Registration No. 34,279

CLAIMS APPENDIX

1.-15. (Canceled).

16. (Previously Presented) In an IP-based network, a system comprising:
at least one server storing application programs for implementing user specific subscribable services, said server storing said services on a per user basis;
and
at least one terminal coupled to the server and having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services.

17. (Previously Presented) The system of claim 16, wherein said user specific subscribable services are supplementary to basic user services.

18. (Previously Presented) The system of claim 16, wherein said user specific subscribable services are supplementary to Internet Telephony service.

19. (Previously Presented) The system of claim 18, wherein said user specific subscribable services can be user configured via said at least one terminal.

20. (Previously Presented) The system of claim 19, wherein said server includes a Java system, and said at least one terminal supports downloading of said application programs.

21.-23. (Canceled).

24. (Previously Presented) In an IP network, a terminal comprising a client component for on-demand requesting of user downloadable application software from a server, said application software is configured to interwork with the application software on at least one other terminal of the network for realizing user services, and is capable of implementing user subscribable services.

25. (Previously Presented) The terminal of claim 24, wherein said application execution component is implemented as a virtual machine.

26. (Previously Presented) The terminal of claim 25, wherein said user subscribable services can be configured via said client component.

27. (Withdrawn) A method for realizing services in an IP-based network, the method comprising the steps of:

providing user services via server in the core of the network; and
executing said user services via a terminal at the network edge.

28. (Withdrawn) The method of claim 27, further comprising the step of realizing supplementary services for Internet Telephony.

29. (Withdrawn) A communication network comprising a core network for providing user services, and terminal at the network edges for executing said user services.

30. (Previously Presented) The system of claim 16 further comprising an application execution component for executing the application program, said application execution component being ported to the terminal only once

31. (Previously Presented) The terminal of claim 24 further comprising an application component for executing said application software, the application execution component being ported to the terminal only once.

EVIDENCE APPENDIX

NONE.

RELATED PROCEEDINGS APPENDIX

NONE